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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058861
Party	Plaintiff Brian S. Gluckstein
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRIAN STEVEN GLUCKSTEIN, an individual, Petitioner, vs. GLUCKSTEINHOME INC., a Canadian corporation, Respondent.	)	Cancellation No. 92-058,861

MOTION FOR RECONSIDERATION OF BOARD DECISION

Pursuant to TBMP 518, Petitioner BRIAN STEVEN GLUCKSTEIN ("Petitioner"), by and through undersigned counsel, respectfully moves for reconsideration of the Board's decision, issued on April 28, 2014, granting Respondent GLUCKSTEINHOME INC.'s ("Respondent") Motion for Suspension. Petitioner submits that a suspension should not be granted in this case because the foreign civil actions, in Ontario Superior Court of Justice and the Federal Court of Canada, on which the request for suspension is based, have no bearing on the final determination of a U.S. registration in that 1) the Lanham Act must govern the validity of U.S. trademark registrations and 2) neither the Ontario Superior Court of Justice nor the Federal Court of Canada have jurisdiction to cancel a U.S. registration. Accordingly, Petitioner respectfully requests that the Board resume these proceedings.

I. Background

On March 12, 2014, Petitioner brought this Petition to Cancel against Respondent's registration for the mark GLUCKSTEINHOME (the "Registration"). On April 23, 2014, Respondent filed its Answer. Shortly thereafter, on Friday, April 25, 2014, Respondent filed a Motion to Suspend (the "Motion") these proceedings pending a final determination of the civil actions between the parties in Ontario Superior Court of Justice and the Federal Court of Canada. The Motion was filed without

consent and without prior notice to Petitioner. In fact, Petitioner was unaware that such Motion had been filed. On the next business day, Monday, April 28, 2014, before Petitioner received even a service copy of the Motion, the Board issued an order granting the Motion and suspended this proceeding.

II. The Board Should Reconsider its Decision to Suspend and Resume This Proceeding

A. Trademark Ownership Rights in the U.S. and the Validity of U.S. Registrations are Governed by the Lanham Act

A trademark is inherently territorial and it exists in each country solely according to that particular country's statutory scheme. *See Fuji Photo Film Co., Inc. v. Shinohara Shoji Kabushiki Kaisha*, 225 U.S.P.Q. 540 (5th Cir. 1985). Once a trademark has been registered in the United States, "its status . . . is independent of the continued validity of its registration abroad, and its duration, validity, and transfer in the United States are governed by" the Lanham Act. *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 109 U.S.P.Q. 438 (2d Cir. 1956), *cert. denied*, 352 U.S. 871, 111 U.S.P.Q. 468 (1956).

Respondent's Motion to Suspend the instant proceeding is based on the pending dispositions of two proceedings in Canada concerning the parties' trademark rights in Canada. The proceedings in Canada have no bearing whatsoever on the U.S. registration at dispute here since once a mark is registered in the U.S., its status, duration, and validity, are governed by the Lanham Act. *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 109 U.S.P.Q. 438 (2d Cir. 1956). Courts have long recognized that foreign trademark decisions have no place in determining the ownership rights of registrations in the U.S. It would be inappropriate to apply Canadian trademark law to determine ownership rights and the disposition of a U.S. registration. This is, in part, because foreign trademark laws, such as Canadian trademark laws, differ greatly from U.S. trademark laws in many respects (*e.g.*, Canada does not have a classification system whereas the U.S. does). Accordingly, while the parties' ownership of certain trademark registrations in Canada should be adjudicated in Canada, the Canadian proceedings and the disposition thereof, should not determine the ownership rights and the validity of a U.S. registration. Regardless of the outcome of the Canadian proceedings, the ownership rights of a U.S. registration must be determined based on U.S. law under the Lanham Act. The Board should resume this Cancellation.

B. U.S. Courts Have Long Determined that Decisions of Foreign Courts Concerning U.S. Trademark Rights are Irrelevant and Inadmissible

It is well-settled law that "when trade-mark rights within the United States are being litigated in an American court, the decisions of foreign courts concerning the respective trade-mark rights of the parties are irrelevant and inadmissible." *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 109 U.S.P.Q. 438 (2d Cir. 1956), *citing George W. Luft Co. v. Zande Cosmetic Co.*, 142 F.2d 536, 539, 61 U.S.P.Q. 424 (2d Cir. 1944); *see also, Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 180 U.S.P.Q. 506 (S.D.N.Y. 1973), *modified on other grounds*, 186 U.S.P.Q. 436 (2d Cir. 1975); *C-Cure Chemical Co. v. Secure Adhesives Corp.,* 220 U.S.P.Q. 545 (W.D.N.Y. 1983), *disagreed with on other grounds*, 6 U.S.P.Q.2d 1950. Courts have routinely held that foreign judgments should not be regarded in Lanham Act cases. *See, e.g.*, *Calzaturificio Rangoni S.p.A. v. U.S. Shoe Corp*., 33 U.S.P.Q.2d 1345 (S.D.N.Y. 1994) ("There is specific United States case law stating that foreign judgments should not be regarded in Lanham Act cases."). Other courts go further to reject the very relevance and admissibility of decisions of foreign courts when U.S. trademark ownership is in issue. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 29:5 (4th ed. 2014); *see also Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 180 U.S.P.Q. 506 (S.D.N.Y. 1973), *modified on other grounds*, 186 U.S.P.Q. 436 (2d Cir. 1975) (rights within U.S. not affected by German decisions about the rights of the parties); *Calzaturificio Rangoni S.p.A. v. U.S. Shoe Corp*., 33 U.S.P.Q.2d 1345 (S.D.N.Y. 1994) (principles of comity do not change holding that decision of Italian court is irrelevant and inadmissible as to trademark rights in the U.S.); *Fuji Photo Film Co. Inc. v. Shinohara Shoji Kabushiki Kaisha*, 225 U.S.P.Q. 540 (5th Cir. 1985) ("It is equally well settled that 'when trademark rights within the U.S. are being litigated in an American court, the decisions of foreign courts concerning the respective trademark rights of the parties are irrelevant and inadmissible.'").

Similarly, the outcome of proceedings in Canada concerning the parties' trademark rights in Canada should have no bearing on the parties' rights concerning a U.S. registration, which is clearly governed by the Lanham Act. *See Calzaturificio Rangoni S.p.A. v. U.S. Shoe Corp*., 33 U.S.P.Q.2d 1345

(S.D.N.Y. 1994) ("The Italian court's adjudication of the AMALFI mark has no application in this action. The use of AMALFI in the United States is governed solely by the trademark laws and decisions of this country. The Italian Judgment, based on Italian law, has no effect on the evaluation of the rights to use AMALFI in the United States."). As courts have routinely held that foreign judgments should not be regarded in Lanham Act cases, the outcome of the Canadian proceedings are irrelevant to the determination of ownership rights in the U.S., and inadmissible.

C. The Canadian Proceedings Do Not Have Any Bearing on the Instant Cancellation Proceeding Since the Validity of U.S. Registrations are Governed by the Lanham Act

The Board may suspend a proceeding when it has come to the Board's attention that the "parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case." 37 C.F.R. § 2.117 (emphasis added). As discussed above, the outcome of the Canadian proceedings are irrelevant to the determination of ownership rights in the U.S., and therefore, have no bearing on the instant Cancellation proceeding.

The Board should allow this Cancellation proceeding to move forward so that it may properly determine the validity of the Registration under the Lanham Act. Allowing the continued suspension of this proceeding pending the disposition of Canadian proceedings would unfairly prejudice Petitioner and result in the improper adjudication of the parties' trademark rights to a U.S. registration under Canadian trademark laws. Moreover, as a Canadian tribunal has no authority to order the cancellation of a U.S. registration, the Board should resume the instant proceeding and allow the parties to be heard.

III. Conclusion

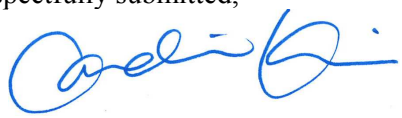
Petitioner respectfully submits that the Canadian proceedings, which occasioned the suspension of these Cancellation proceedings, can have no bearing on the parties' U.S. trademark ownership rights and the validity of a U.S. registration. Therefore, it is improper to suspend these proceedings pending the disposition of the Canadian proceedings.

Accordingly, as the pending disposition of proceedings in Canada have no bearing on the determination of trademark ownership rights in the U.S. and the continued validity of the Registration,

Petitioner respectfully requests that the Board reconsider its grant of Respondent's Motion to Suspend and order the resumption of these proceedings.

Respectfully submitted,

Dated: May 16, 2014

By: 

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **MOTION FOR RECONSIDERATION OF BOARD DECISION** upon Respondent by depositing one copy thereof in the U.S. Mail, First-Class, postage prepaid, on May 16, 2014 addressed as follows:

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